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10/561,550	02/23/2007	Hideji Tajima	10287.76	6278
27683	7590	10/14/2010	EXAMINER	
HAYNES AND BOONE, LLP			KILPATRICK, BRYAN T	
IP Section			ART UNIT	
2323 Victory Avenue			PAPER NUMBER	
Suite 700			1772	
Dallas, TX 75219			MAIL DATE	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/561,550

Applicant(s)

TAJIMA ET AL.

Examiner

BRYAN T. KILPATRICK

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2010.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) 4, 5, 13-16 and 21-28 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-3, 6-12 and 17-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 20 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendments and arguments/remarks filed on 20 July 2010 have been entered and fully considered.
2. Instant claims 1 and 17-18 have been amended by Applicant's amendment.
3. Instant claims 4-5, 13-16, and 21-26 have been amended by Applicant's amendment.
4. Instant claim 29 is added newly.
5. Instant claims 27-28 are previously withdrawn from consideration.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I - claim(s) 1-12 and 17-20, drawn to a sample arraying/assembling device with a distribution section and a method of distributing samples.

Group II - claim(s) 13-16 and 21-23, drawn to a sample arraying/assembling device with detachable components and a method of assembling components.

Group III - claim(s) 24, drawn to a wound body.

Group IV - claim(s) 25, drawn to a sample arraying/assembling device comprising an assembly body.

Group V - claim(s) 26, drawn to a sample arraying/assembling device having a translucent or semitranslucent pipette tip and an optical acquisition section.

The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The special technical feature of Group I is a distribution section with a method of distributing samples claimed therein which is not present in Groups II-V. The other claimed special technical features are detachable components with a method of assembly for Group II, a wound body for Group III, an assembly body for Group IV, and a translucent/semitranslucent pipette tip and an optical acquisition section for Group V.

Applicant's election of Group I, claims 1-12 and 17-20, in the reply filed on 29 October 2009 is acknowledged. **Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse** (MPEP § 818.03(a)).

Newly submitted claims 27-28 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: instant claims 27-28 cite a "rotating section" that is cited in the nonelected claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. **Accordingly, claims 27-28 are withdrawn from consideration as being directed to a non-elected invention.** See 37 CFR 1.142(b) and MPEP § 821.03.

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 20 June 2009. It is noted, however, **that applicant has not filed a certified copy of the 2003-177228 application** as required by 35 U.S.C. 119(b).

Applicant's filed request for the USPTO to retrieve the electronic priority application(s) filed on 20 July 2010 has been entered and noted.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3, 6-12, 17, and 29 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2001/0046699 (Tajima).

In regards to instant claims 1-3 and 29, Tajima discloses an invention for positioning substances for detection, a film for use in positioning substances for detection, and a manufacturing method for a carrier for substances for detection. The invention has a dispenser(s) having at least one material holding conduit and a suction/discharge device (Abstract). The invention discloses positioning dispensers (12

and 14 of Fig. 1) along XYZ axes such as in a matrix or array in paragraph [0080]. The invention discloses the use of a spiral disk shaped carrier for substance detection manufactured using a thin slice of rolled film (Fig. 7 and paragraph [0047]), similarly to the wound body made of a string or thread-like member of instant claim 1 with a flat face or surface. Tajima discloses winding a base member while maintaining an organized spacing so as to allow a sample that has been distributed can easily pass through the spacing (Fig. 10 and paragraphs [0116]-[0118]).

Even though Tajima does not expressly disclose the use of a prism shaped wound body, it is well known in the art and the field of geometry of prism shapes having many edges that form a disk-like shape such as a decagonal prism. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the disk shaped rolled film of Tajima similarly as the prism wound body of the instant claims.

In regards to instant claims 6-7, Tajima discloses positioning dispensers (12 and 14, or 37 and 39 of Fig. 1). The dispensers have nozzles (13, or 36 and 38 of Fig. 1) for dispensing sample paragraphs [0079]-[0080] and [0091].

In regards to instant claim 8, Tajima discloses the use of a displacement device (Abstract).

In regards to instant claims 9-10, Tajima discloses the use of concave and convex sections in paragraph [0106].

In regards to instant claim 11, Tajima discloses the use of markings with a spiral produced from producing a spiral disk shaped carrier from a rolled film (paragraph [0047]).

In regards to instant claim 12, Tajima discloses a table (15 of Fig. 1) and a displacement device (paragraph [0080]).

In regards to instant claim 17, Tajima discloses an invention for positioning substances for detection, a film for use in positioning substances for detection, and a manufacturing method for a carrier for substances for detection. The invention has a dispenser(s) having at least one material holding conduit and a suction/discharge device (Abstract). The invention discloses positioning dispensers (12 and 14 of Fig. 1) along XYZ axes such as in a matrix or array in paragraph [0080]. Tajima discloses the use of an integrated core with film rolled around it in paragraph [0051]. The invention discloses the use of a spiral disk shaped carrier for substance detection manufactured using a thin slice of rolled film (Fig. 7 and paragraph [0047]), similarly to the wound body made of a string or thread-like member of instant claim 1 with a flat face or surface. Tajima discloses winding a base member while maintaining an organized spacing so as to allow a sample that has been distributed can easily pass through the spacing (Fig. 10 and paragraphs [0116]-[0118]).

Even though Tajima does not expressly disclose the use of a prism shaped wound body, it is well known in the art and the field of geometry of prism shapes having many edges that form a disk-like shape such as a decagonal prism. Therefore, it would

have been obvious to one of ordinary skill in the art at the time the invention was made to employ the disk shaped rolled film of Tajima similarly as the prism wound body of the instant claims.

Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2001/0046699 (Tajima), and in further view of U.S. Patent 5,895,631 (Tajima-2).

Instant claims 18-20 recite a method of distributing samples on a string or thread-like slender foundation member comprising a holding step and a contact step. Tajima discloses an invention for positioning substances for detection, a film for use in positioning substances for detection, and a manufacturing method for a carrier for substances for detection. The invention has a dispenser(s) having at least one material holding conduit and a suction/discharge device (Abstract). The invention discloses positioning dispensers (12 and 14 of Fig. 1) along XYZ axes such as in a matrix or array in paragraph [0080]. The invention discloses the use of a spiral disk shaped carrier for substance detection manufactured using a thin slice of rolled film (Fig. 7 and paragraph [0047]), similarly to the wound body made of a string or thread-like member of instant claim 1 with a flat face or surface. Tajima discloses winding a base member while maintaining an organized spacing so as to allow a sample that has been distributed can easily pass through the spacing (Fig. 10 and paragraphs [0116]-[0118]).

Even though Tajima discloses a device capable of performing the method of the instant claims, Tajima does not expressly disclose a method comprising a holding step and a contact step. However, Tajima-2 discloses a liquid processing method for using a pipette device to pipette a substance from inside a vessel and transferring the substance to another liquid or target (Abstract of Tajima-2), which encompasses the holding and contact steps of the instant claims. Since the Abstract of Tajima discloses an apparatus that employs a suction/discharge device that is similar to the pipette device disclosed in the Abstract of Tajima-2, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the apparatus of Tajima to perform the method of Tajima-2 for the purpose of transferring a liquid from one location to another for the purpose of executing an analysis process such as detection (Abstract of Tajima-2, and paragraph [0142] of Tajima).

Response to Arguments

Applicant's arguments with respect to claims 1 and 17-18 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRYAN T. KILPATRICK whose telephone number is (571)270-5553. The examiner can normally be reached on Monday - Friday, 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, In Suk Bullock can be reached on (571)272-5954. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. T. K./
Examiner, Art Unit 1772

/SAM P SIEFKE/
Primary Examiner, Art Unit 1772